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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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WH51/1102

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EXAMINER

KOSTAK, V

ART UNIT

PAPER NUMBER

2611

10

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 10

Application Number: 09/234,559

Filing Date: January 20, 1999

Appellant(s): Sundaram Ramakesavan

Timothy N. Trop
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed September 22, 2000.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 1-26.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

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(6) *Issues*

The appellant's statement of the issues in the brief is correct. The Examiner questions, however, appellant's somewhat presumptuous presentation of the (sole) issue as a rhetorical question, which, moreover, can be considered mischaracterized.

(7) *Grouping of Claims*

The rejection of claims 1-26 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. Appellant mentions groupings based on brevity, but does not specify which "stand or fall together". See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

6,025,868

RUSSO

2-2000

(10) *Grounds of Rejection*

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The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-26 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office action, Paper No. 5.

(11) Response to Argument

The examiner herein emphasizes his arguments provided in the final rejection. Russo gives clear and explicit disclosure describing his “pause” and “resume” modes (col. 11 lines 14-17) without specifying the exact hardware. Appellant’s basic argument (covering independent claims 1, 4, 10 and 14; similar independent claim 16 is not argued) is unpersuasive because he concludes that since no hardware is specified (even though his claims are hardly expressive), *Russo cannot carry out those functions*. This position is therefore erroneous.

It is unquestionable that one of ordinary skill in the art would necessarily conclude that since Russo provides “pause” and “resume” type functions (which Russo explicitly describes), his system accordingly contains means for carrying them out. The skilled artisan can and would immediately and definitely accept that Russo’s system, for example can distinguish between the “pause” and “resume” functions based on electrical impulses since his system is electrically powered, although this is not explicit in Russo. These impulses are codes in a basic sense. This is also not specified in Russo. The user naturally makes the selection using some interfacing (e.g. button), which also is not explicit. Russo does not even mention the

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headend station, which it and all of its necessary components *must* be included to enable communication. The examiner and anyone of ordinary skill in the art can very reasonably deduce these and other concepts from the text in Russo.

Appellant, on the other hand, reasons that since specific means are not spelled out, then Russo does not - since he cannot - provide these functions. But Russo *does* carry them out, which cannot be refuted.

Similarly regarding claims 21, 22 and 24, it must be derived from Russo that the “pause” and “resume” modes are carried out in a controlled manner, especially since Russo includes a controlling unit (element 150), as pointed out in the final Office action. The system of Russo *must* identify the selected modes in order to carry them out. Furthermore, since Russo can download plural programs, he *must* be able to distinguish between them with some type of ID, which the skilled artisan, once again, would naturally deduce, using numbers or characters. The headend *must* be able to be contacted by the user’s end to download whatever chosen programs. Each program *must* be identified at the headend and by the user to access each one. The headend *must* have a controller, as the user’s end does, to carry out all process in an organized manner, etc, etc. Russo does not need to specify any of this. All of this can very reasonably be deduced by the skilled artisan from the Russo disclosure.

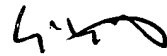
However, Appellant once again erroneously concludes that since Russo does not describe the mode selection in a controlled manner, one of ordinary skill in the art is

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disallowed from realizing this and anything related to the "pause" and "resume" modes explicitly described in the Russo disclosure.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



VRK

October 30, 2000

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